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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

DASS, HARISH T

ART UNIT PAPER NUMBER

3628

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,313

Applicant(s)

CHIN, STEPHEN

Examiner

Harish T Dass

Art Unit

3628

The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11-14 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Examiner was unable to find the following limitation or suggestion in original specification "in response to and substantially contemporaneous with consummation of a transaction between the sender and recipient" particularly the "substantially contemporaneous" could not be found in original specification. Claims 11-14 remain rejected since, Applicant did not remove or amended objected matter(s) from claimed limitation, and the wording cannot be changed.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3628

Claims 11, 13-15, 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jennings et al (Hereinafter Jennings, US Pat. 5,825,003) in view of Schrader et al (hereinafter Schrader – 5,903,881) and Mori et al (hereinafter Mori – US 6,085,168).

Re. Claim 11, Jennings discloses storing in a stored value account (place transfer funds into transfer holding fund) of a sender electronic funds that are available for transfer to a recipient [see entire document particularly, abstract; figures; C2 L36-L62; C4 L1-L5; C26 L56-L60; C27 L58-L62], receiving a request over ATM Network (through the use of a terminal such as an ATM, home banking phone, personal computer, conventional telephone or the like) at a server computer to transfer at least some of the funds in the stored value account to a recipient, in response to and substantially contemporaneous (instantly) with consummation (settlement) of a transaction between the sender and recipient [abstract; C1 L45 to C2 L62; C3 L50 to C4 L13; C5 L42 to C5 L55 to C6 L40; C27 L48 to C28 L22], sending the requested funds to the recipient [C4 L1-L5; C13 L44 to C14 L40; C18 L20-L67], and debiting the stored value account [C5 L30-L40; C8 L3-L43; C27 L48 to C28 L20]. Jennings discloses electronic fund transfer over the ATM network or the like. But, Jennings does not explicitly disclose transfer over the Internet and the request being received in response to and substantially contemporaneous with consummation of a transaction between the sender and recipient. However, Schrader et al (hereinafter Schrader – 5,903,881) discloses online banking and electronic fund transfer system and use of Internet [Abstract; C12 L35-L53; C13 L45-L60] to access financial institution computer system, support online payment and transfer fund. Further,

Art Unit: 3628

Mori discloses an electronic commerce settlement system where a payee can receive payment online through a network, etc. when goods are purchased and the request being received in response to and substantially contemporaneous with consummation of a transaction between the sender and recipient [see entire document particularly, abstract, Figures; C7 L1 to C8 L2; C29 L3-L12] for final settlement admission request from the purchaser who received goods. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosure of Jennings, Schrader and Mori to facilitate payments of the purchasing of goods from an Internet auction sites and enable the customers and merchants to make payment using Internet system and process financial transaction more cost effective, fast and cheaper way.

Re. Claim 15, Jennings further discloses receiving a request from a sender at a server computer to transfer funds to a recipient, wherein the request includes information on a payment instrument to be used to pay the funds to the recipient [C3 L50-L67; C4 L14-17; C5 L42 to C6 L40; C27 L48 to C28 L22], from the computer, sending an authorization request to charge the payment instrument [Abstract; Figures 12-14; C1 L45 to C2 L62; C26 L52 to C27 L20; C17 L45-L67], receiving at the server computer an authorization to charge the payment instrument [Abstract; Figures 12-14; C1 L45 to C2 L62; C26 L52 to C27 L20; C5 L9-L30; C17 L45-L67], and providing the requested funds to the recipient [C5 L42 to C6 L8; C9 L17 to C10 L50; C28 L1-L22]. Jennings does not explicitly disclose server computer. However, Schrader further discloses server

Art Unit: 3628

computer [Figure 13; C12 L28 to C13 L7; C15 L5-L27] to allow the Internet based communication. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Jennings and include computer server, as taught by Schrader, to allow the client computer download a configuration file which contains the financial institutions description information.

Re. Claims 13-14 and 17-18, Jennings further discloses confirmation message is displayed to the customer [C9 L17-L32; C11 L10 to C12 L50; C14 L29-L45]. Jennings does not explicitly disclose email. However, Schrader discloses email messages [C19 L25-L45] to allow the user to receive email message from financial institution or send message to financial institutions. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Jennings and add email to allow the user to get message for inquiries about specific transactions.

Re. Claims 19 and 20, Jennings further discloses wherein the recipient is a merchant (point of sale) [C8 L38].

Re. Claim 21 Mori further discloses wherein the payment instrument is a credit card [Figure 47; C1 L1 to C2 L19; C55 L25 to C58 L57] to use a magnetic card or an IC card, etc. for transfer of provisional settlement money.

Art Unit: 3628

Claims 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jennings in view of Schrader and Mori as applied to claims 11 & 15 above, and further in view of Nethery (US 6,070,798).

Re. Claims 12 and 16, neither Jennings nor Schrader or Mori discloses generating a money order in the name of the recipient, and wherein the requested funds are sent by sending the money order. However, Nethery discloses this step [Abstract; Figure 5; C1 L5 to C2 L38] to enable remote purchase over a network. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Jennings and Schrader to add money negotiable instrument such as money order to be send through electronic communication link.

Response to Arguments

3. Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 3628

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T Dass whose telephone number is 703-305-4694. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S Sough can be reached on 703-308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harish T Dass
Examiner
Art Unit 3628
11/14/04

